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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,541	03/30/2004	Awdhoot Vasant Kerkar	FDN-2831	3421
7590	01/05/2009		EXAMINER	
William J. Davis Building Materials Investment Corporation, Legal Department 1361 Alps Road Wayne, NJ 07470			CHEVALIER, ALICIA ANN	
			ART UNIT	PAPER NUMBER
			1794	
			MAIL DATE	
			01/05/2009	DELIVERY MODE
				PAPER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/812,541

Filing Date: March 30, 2004

Appellant(s): KERKAR ET AL.

Rachel J. Lin
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 14, 2008 appealing from the Office action mailed July 25, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

4,738,884	ALGRIM et al.	04-1988
2,326,724	FASOLD et al.	08-1943

Definition of "Basal Cleavage", Wikipedia, online encyclopedia, Jan. 7, 2007.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. Claims 1-3, 5-8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Algrim et al. (U.S. Patent No. 4,738,884) in view of Fasold et al. (U.S. Patent No. 2,326,724) and evidenced by Wikipedia.

Regarding Appellant's claim 1, Algrim discloses a roofing shingle (*col. 5, line 19*) comprising a top and bottom surface (*figures 1 and 2*). The bottom surface is provided with a release coating of a continuous film (*col. 5, line 20 and 33-46*). The release coating is disposed only on a pressure point portion of the bottom surface (*figure 2, ref. #14*). The release material prevents stacked shingles from sticking together during packing (*col. 5, lines 25-30*). The particles are in the class phyllosilicates, such as talc (*col. 1, lines 26-27*)

Algrim fails to disclose that the release coating has particles with a good to perfect basal cleavage.

Fasold discloses a roofing shingle (*col. 1, lines 8-9*) comprising a top and bottom surface (*figure 4*). The bottom surface is provided with a release coating of a continuous film of particles (*col. 13, lines 33-37 and col. 1, lines 26-31*).

Fasold further discloses that the particles on the bottom surface prevent sticking of the adjacent layers of the roofing material in a package (*col. 1, lines 26-31*). Basal cleavage is cleavage parallel to the base of a crystal, or to the plane of the lateral axes making the material feel slippery (*see wikipedia print out*).

Algrim and Fasold are analogous because they both disclose release materials for roofing articles.

It would have been obvious to one of ordinary skill in the art at the time of the invention to add the particles of Fasold to the release material of Algrim in order to insure that the bottom surface of an adjacent layer of roofing material does not stick together in a package.

Furthermore, the exact basal cleavage of the particles is deemed to be a result effective variable with regard to the release property of the particles. It would require routine experimentation to determine the optimum value of a result effective variable, such as basal cleavage, in the absence of a showing of criticality in the claimed basal cleavage. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill in the art would have been motivated to use a good to perfect basal cleavage in order to increase the release properties, i.e. slipperiness, of the particles and prevent sticking.

Regarding Appellant's claim 2, in figure 2 of Algrim it shows that the pressure point portion is immediately above and below a top edge of the bottom surface, where the top edge overlaps a bottom portion of a headlap portion of the top surface.

Regarding Appellant's claim 3, Algrim discloses that the roofing shingle is a shingle selected from the group consisting of a laminated shingle and a strip shingle (*figures 1-4*).

Regarding Appellant's claim 5, Fasold discloses that the particles are in the class phyllosilicates, such as talc (*col. 1, lines 26-27*).

Regarding Appellant's claims 6-8 and 10, Algrim discloses a wherein the top surface of each roofing shingle faces the bottom surface of its adjoining roofing shingle (*col. 5, lines 28-32 and figure 4*).

10) Response to Argument

2. Appellant's arguments in the Appeal Brief, filed October 14, 2008, regarding the 35 U.S.C. 103(a) rejection over Algrim et al. (U.S. Patent No. 4,738,884) in view of Fasold et al. (U.S. Patent No. 2,326,724) of record have been carefully considered but are deemed unpersuasive.

Appellant argues that one of ordinary skill in the art would not look at the talc taught in Fasold, which is to be applied to the entire surface of the roofing material, and combine it with Algrim to apply it to only the strip release material. Appellant further states that Algrim and Fasold do not provide a teaching or suggestion that the talc of Fasold would adequately prevent sticking when applied directly to the shingle, and to only the "pressure point" portion of the shingle taught by Algrim.

The Examiner respectfully disagrees with this interpretation of the combination of the references. One of ordinary skill in the art would have looked to Fasold because Fasold and Algrim are both solving a similar problem, e.g. preventing adjacent layers of roofing material from sticking together. That fact that Algrim is reducing the amount of release material required to prevent sticking to a subsequent roofing material when stacked would not prevent one of ordinary skill in the art from exploring prior art that applies release material to the entire lower surface. Therefore one of ordinary skill in the art would look to both Fasold and Algrim to solve the problem of preventing stacked layers of roofing material from sticking to each other.

Furthermore, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In this case, one of ordinary skill would recognize that talc has release properties sufficient to prevent sticking between stacked roofing material. Appellant has not provided evidence that the talc of Fasold would adequately prevent sticking when applied directly to the shingle, and to only the "pressure point" portion of the shingle taught by Algrim. Attorney argument is not evidence unless it is an admission, in which case, an examiner may use the admission in making a rejection.

Appellant further argues that combining Algrim with Fasold in the manner asserted by the Examiner would not result in the presently claimed invention, and moreover would render the shingle of Algrim unsatisfactory for its intended purpose. Appellant further states that in order to arrive at the present invention, the combination of Algrim and Fasold would have to

suggest getting rid of the release material [of Algrim] entirely and applying a phyllosilicate only to that portion of the shingle it self. Appellant also points out that the present claims are directed to application of phyllosilicate directly to the surface of the shingle in a non-reversible manner.

First, none of the pending claims require the phyllosilicate directly applied to the surface of the shingle in a non-reversible manner. Claim 1 only requires that the release coating of a continuous film of phyllosilicate particles is disposed only on a pressure point portion of the bottom surface. It is the claims that define the claimed invention, and it is claims, not specification that are anticipated or unpatentable. Second, the Examiner has never argued to completely remove the release material strips of Algrim. The Examiner is arguing that it would have been obvious to one of ordinary skill in the art at the time of the invention to *add the particles of Fasold to the release material of Algrim* in order to insure that the bottom surface of an adjacent layer of roofing material does not stick together in a package. Third, Appellant has not provided any evidence that adding talc to the release material of Algrim would render the shingle of Algrim unsatisfactory for its intended purpose. Therefore, the Examiner maintains that it would have been obvious to combine the teachings of Algrim and Fasold as described above.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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